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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUSTIN MORTENSEN and JAMES PATE

Appeal 2009-005297
Application 10/621,085
Technology Center 2100

Decided: April 22, 2010

Before JOHN A. JEFFERY, JEAN R. HOMERE, and JAY P. LUCAS, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants invented a computer-aided design (CAD) management system that manages data having different file types. *See generally* Spec. 1. We reproduce claim 1 below with the key disputed limitations emphasized:

1. A method of managing CAD data in a plurality of disparate and diverse databases comprising:

providing a first database located in a first location and further being located behind a first firewall;

providing a second database located in a second location and further being located behind a second firewall;

providing a clearinghouse server located outside of said first firewall and said second firewall, said clearinghouse server having a clearinghouse database comprising an index to at least a portion of said CAD data in said first database and at least a portion of said CAD data in said second database;

providing a workstation located behind said first firewall, said workstation having a clearinghouse interface program;

establishing communications between said clearinghouse interface program with said clearinghouse server;

transmitting a request for a requested file from said clearinghouse interface program to said clearinghouse server;

determining that said requested file is located in said second database by using said clearinghouse database;

sending a request from said clearinghouse server to said second database for said requested file;

converting said requested file to a first transmittable format *without content change of said requested file*; and

transmitting said requested file from said second database in said first transmittable format.

The Examiner relies on the following as evidence of unpatentability:

Cianfrocca	US 6,088,796	July 11, 2000
Ananian	US 6,922,701 B1	July 26, 2005 (filed Aug. 3, 2000)
Shapiro	US 2006/0005126 A1	Jan. 5, 2006 (filed Oct. 7, 2003 and claiming priority to Provisional App. No. 60/416,255, filed Oct. 7, 2002)

THE REJECTION

The Examiner rejected claims 1-11 under 35 U.S.C. § 103(a) as unpatentable over Cianfrocca, Ananian, and Shapiro. Ans. 4-13.[1]

CLAIM GROUPING

Although Appellants argue independent claim 1 (App. Br. 8-15) separately from independent claim 7 (App. Br. 15-22), the arguments are commensurate with those presented for claim 1. *See* App. Br. 8-22. Regarding other contentions, Appellants group claims 1 and 7 together. *See* App. Br. 22-27. As for dependent claims 2-6 and 8-11, Appellants rely on

[1] Throughout this opinion, we refer to (1) the Appeal Brief filed February 28, 2008; (2) the Examiner's Answer mailed April 29, 2008; and (3) the Reply Brief filed June 30, 2008.

the arguments for claims 1 and 7. *See* App. Br. 22. Accordingly, we group all claims together and select independent claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONTENTIONS

Regarding representative independent claim 1, the Examiner finds that Cianfrocca discloses the first five recited steps, except for having a clearinghouse database comprising an index of CAD data for the databases. Ans. 4-5. The Examiner relies on Ananian to teach (1) this missing limitation and (2) the last five method steps of claim 1. Ans. 5-6. According to the Examiner, Ananian's format conversion (e.g., the plan set standardization 60 function) teaches converting the requested file to a first transmittable format step (Ans. 6), and also that the profiling engine 30 can translate or convert information with CAD files into user-friendly format (Ans. 14). The Examiner also relies on Shapiro to teach the step of converting files without changing their content. Ans. 7-8.

Appellants argue that Ananian discloses enhancing the content of the requested file during conversion and thus teaches away from "converting said requested file to a first transmittable format without content change of said requested file" as recited in claim 1. App. Br. 8-11; Reply Br. 4-5. Appellants further assert that Shapiro does not teach converting the format data without adding content (App. Br. 13), and Shapiro teaches away from the claimed invention since the converted files are changed. App. Br. 13-14; Reply Br. 8, 9 and 13-16.

The issues before us, then, are as follows:

ISSUES

(1) Under § 103, has the Examiner erred in rejecting claim 1 by finding that Cianfrocca, Ananian, and Shapiro collectively would have taught or suggested converting a requested file to a first transmittable format without content change?

(2) Does Ananian teach away from combining its disclosure with Cianfrocca such that an ordinarily skilled artisan would have been discouraged from following the path set out in Ananian?

FINDINGS OF FACT (FF)

(1) Ananian teaches an interactive profile system 10 useful in estimation, design, and construction of a building, and is developed from a plan set in CAD format having physical descriptions of a building. The system 10 contains an application engine 20 and a profiling engine 30 that are programs based within a computer or server. Ananian, col. 2, ll. 43-47, col. 4, ll. 14-26, and col. 9, ll. 7-9; Fig. 1.

(2) When the user 25 submits the plan set, the plan set 50 is standardized into standardized data set 65. The profiling engine 30 converts the standardized plan set into an extracted data set 85, which develops the architecturally correct plan set into the enhanced profile database 40 and is in a format accessible by the query capabilities of the application engine 20. The enhanced profile database 40 has a format compliant with an enhanced

data protocol and establishes a standard framework for the interrelationship development of the building components. Ananian, col. 5, ll. 4-10 and 48-57; col. 8, ll. 1-27; Figs. 1 and 3.

(3) Ananian teaches that the user 25 interfaces with, and directs a profile query 177 to, the application engine 20[2] using a web browser. The application engine 20 directs the profile request 177 to the enhanced profile database 40. The enhanced profile database creates a listing of at least one of the enhanced profile database's interrelated elements to the query, and the application engine 20 returns the profile response 178 to the user's web browser. Ananian, col. 13, ll. 15-37 and col. 14, ll. 34-39; Fig. 1.

(4) In Ananian, the external databases 100 (e.g., databases 101-110) interface with application engine 20 to develop links and relationships between building components within the enhanced profile database 40. For example, component pricing and regulatory data from the external databases 100 are linked to extracted CAD data set 85. As another example, the application engine 20 can cross reference the enhanced profile database 40 with a reference database 107 or regulatory database 108 to check code requirements or cost calculations. Yet another example includes accessing the linked data when the user 25 modifies a component in a query. Ananian, col. 8, l. 30-col. 9, l. 62, col. 11, ll. 4-20, and col. 22, ll. 36-39; Figs 1 and 3.

[2] In one occurrence, Ananian misstates "application engine 10." *See* col. 8, l. 52. However, the application engine is labeled 20 in Figure 1 and described as reference numeral 20 in the rest of the disclosure.

(5) Ananian teaches that assets that relate to components of the enhanced profile database 40 can be tracked with data entered into an asset profile database 128.[3] Col. 22, ll. 7-61; Fig. 1.

PRINCIPLES OF LAW

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn,* 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative claim 1. At the outset, we note that Appellants have only challenged the Examiner's finding that the cited references teach converting the requested file to a first format without changing the content of the file. *See* App. Br. 8-27; Reply Br. 2-16. We thus adopt the Examiner's finding that Ananian teaches the recited steps of: (1) transmitting a request for a requested file from the clearinghouse interface program to the clearinghouse server; (2) determining the requested file is located in the second database by using the clearinghouse database, and (3) sending a request from the clearinghouse server to the second

[3] Although Ananian's Figure 1 labels the asset profile database with reference number 130, we nevertheless find that the proper reference number for this element is 128, as used in the disclosure. *See, e.g.,* col. 22, l. 9. Reference numeral 130 is used to describe a project as shown in Figure 2. *See, e.g.,* col. 16, l. 57.

database for the requested file. *See* Ans. 5-7. Moreover, since the Examiner admits that Cianfrocca does not disclose the converting step (Ans. 5), our analysis will focus on Ananian and Shapiro.

Ananian's interactive profile system 10 is useful in a building design that contains programs including an application engine and a profiling engine within a server. FF 1. In Ananian, the user interfaces with the application engine by directing a profile query to the application engine within a server or transmits a request for a file from the workstation (e.g., user's web browser) to a clearinghouse server. FF 3. The application engine 20 within the server, in turn, directs the profile request to the enhanced profile database 40. *Id.* The enhanced profile database creates the requested file as a listing of at least one of the enhanced profile database's interrelated elements to the query, and the application engine returns the requested file to the user's web browser. *Id.* Thus, Ananian teaches transmitting a request for a file (e.g., 177) from an interface program to a server.

Additionally, since the application engine 20 is a program that interfaces with the enhanced profile database 40, the engine can be considered as part of the clearinghouse database that indexes CAD data from other databases. That is, database 40 indexes CAD data from: (a) plan set or database (FF 2); (b) pricing and regulatory data of the external databases linked to extracted CAD data set (FF 4); and (c) data related to the asset profile database (FF 5). For example, the external databases 100 (e.g., databases 101-110) interface with application engine 20 to develop potential links and relationships between building components within the enhanced profile database 40 and thus create an index to CAD data in different databases. *Id.* Nonetheless, we note also that the recitation to "CAD data"

in claim 1 merely pertains to its content and is therefore non-functional descriptive material that entitled to no patentable weight. *See In re Ngai,* 367 F.3d 1336, 1339 (Fed. Cir. 2004).

Furthermore, the clearinghouse database (e.g., 20 and 40) directs a user's request to these determined second database for information or the requested file: (a) if a user requests the price of a building component (*see* FF 4); (b) if a user modifies a query (*see id.*); or (c) for cross-referencing the database to check code requirements or cost calculations (*see id.*). Moreover, Ananian also suggests that the requested data in these databases must be converted into an enhanced data protocol or format (FF 2) prior to transmission back to the clearinghouse database (e.g., 20), so that a standard framework for developing interrelationships and links between building components can be accomplished. *See* FF 2 and 4. Ananian therefore at least suggests that all the data that is transmitted from these databases must be converted into a standard first transmittable format as recited in claim 1.

Also, contrary to the Appellants' assertions (App. Br. 9 and 11; Reply Br. 4), Ananian does not teach modifying or changing the requested file or the content of requested information (e.g., a listing or data from external databases 100). Rather, Ananian discusses adding links and interrelationships to *the database's content* and not the requested file. Thus, even assuming, without deciding, that Ananian's database 40 is modified or the standardized data set 60 is different from that originally submitted by the user (App. Br. 9-11; Reply Br. 4-5), Ananian still teaches the *requested file's content* is not changed during conversion. We therefore disagree with

Appellants (App. Br. 8-11) that Ananian fails to teach the step of "converting said requested file to a first transmittable format without content change of said requested file" as recited in claim 1.

Finally, we are not persuaded that combining Ananian with Cianfrocca teaches away from Cianfrocca's or Appellants' invention, as Appellants argue. App. Br. 11; Reply Br. 5. We find no evidence that one skilled in the art would be discouraged from combining Ananian's teachings with Cianfrocca because Ananian teaches the database—not the requested data—is enhanced. *See Kahn*, 441 F.3d at 990. As explained above, augmenting a database does not teach that the requested file will be converted to a format with content change, as Appellants contend. *See* App. Br. 11. We therefore find that Ananian teaches the recited limitation of converting the requested file to a first transmittable format without content change as recited in claim 1.

Since Ananian teaches all the limitations missing from Cianfrocca, Shapiro is cumulative. We therefore need not address Appellants' arguments directed to Shapiro's purported deficiencies. *See* App. Br. 11-15.

For the foregoing reasons, Appellants have not shown error in the obviousness rejection of independent claim 1 based on the combination of Cianfrocca, Ananian, and Shapiro. We will therefore sustain the rejection of claim 1, and claims 2-11 which fall with claim 1.

CONCLUSION

The Examiner did not err in rejecting claims 1-11 under § 103.

ORDER

We affirm the Examiner's decision rejecting claims 1-11.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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